



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/937,716 | 07/01/2002 | Malcolm Maden | 550-266 | 7012 |

7590 03/23/2006
THOMAS J. KOWALSKI, ESQ.
FROMMER LAWRENCE AND HAUG, LLP
745 FIFTH AVENUE
NEW YORK, NY 10151

EXAMINER

GUCKER, STEPHEN

ART UNIT PAPER NUMBER

1649

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/937,716

Applicant(s)

MADEN ET AL.

Examiner

Stephen Gucker

Art Unit

1649

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Any objections or rejections made in a previous Office Action that are not herein reinstated have been withdrawn.
3. The Examiner sincerely thanks Applicant's representative for indicating that the Examiner did indeed err in overlooking claims 7-9, and the Examiner apologizes for this oversight and is appreciative of the gentle manner in which Applicant's representative resolved the issue. If it matters any, the Examiner notes that claims 7-9 would not have belonged to the same inventive Group as claims 1-6, and would have been subject to restriction had the Examiner not overlooked these claims. (Claims 7-8 belong to a gene therapy group even though claim 7 depends on claim 5, and claim 8 is a composition claim).
4. Claims 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by WO96/23070 (IDS filed 10/1/01, "Lamph") for reasons of record and the following. Lamph discloses that retinoic acid (RA) and other agonist retinoids activate RAR β polypeptides by binding to them (pages 1-4). Additionally, Lamph discloses that RA and other agonist retinoids can be used to treat diseases, including neurological diseases such as Alzheimer's, Parkinson's, and Lou Gehrig's disease (pages 16-17 and page 36, lines 21-25).

Applicant's arguments filed 1/6/06 have been fully considered but they are not persuasive because Applicant argues that Lamph does not teach or suggest a method

Art Unit: 1649

of producing neurite outgrowth by contacting a neuronal cell with an agonist of RAR β 2. This is absolutely true as Lamph does not explicitly teach neurite outgrowth resulting from the administration of RA or other RAR β 2 agonists. Unfortunately, Lamph clearly discloses the act or manner of treating, such as administration of RA to patients with Alzheimer's, Parkinson's, or Lou Gehrig's disease, who possess neuronal cells that will be contacted by RA and other RAR β 2 agonists that are indistinguishable from the instant methods and are encompassed by the instant claims. Both the instant methods and the prior art methods inherently include the phenomenon of producing neurite outgrowth because the RA used in both methods is the same identical substance and nothing distinguishes the instant Application's disclosure of administering RA from the prior art. If RA's inherent properties include stimulating neurite outgrowth when contacting a neuronal cell, the prior art anticipates the instant invention, regardless of whether there is an explicit disclosure in the prior art of all the inherent properties of the administered RA. The actual method or process step of administering the RA is the same in both the instant invention and the prior art reference (Ex parte Novitski, 26 USPQ 1391).

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 1649

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. No claim is allowed.

7. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technical Center 1600 general number which is (571) 272-1600.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gucker whose telephone number is (571) 272-0883. The examiner can normally be reached on Monday to Friday from 0930 to 1800. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached at (571) 272-0867. The fax phone number for this Group is currently (571)-273-8300.

SG

Stephen Gucker

March 20, 2006


JANET L. ANDRES
SUPERVISORY PATENT EXAMINER